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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,625	01/09/2002	Francis Ambrose Broderick	FR920000074US1	4352
45092	7590	03/25/2009		
HOFFMAN WARNICK LLC 75 STATE ST 14TH FLOOR ALBANY, NY 12207			EXAMINER FEENEY, BRETT A	
			ART UNIT 4114	PAPER NUMBER
			NOTIFICATION DATE 03/25/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOCommunications@hoffmanwarnick.com

Office Action Summary	Application No.	Applicant(s)	
	10/042,625	BRODERICK ET AL.	
	Examiner	Art Unit	
	BRETT FEENEY	4114	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Claims

1. The following is a final office action in response to the response received on October 22, 2008.
2. Claims 1, 4 and 5 have been amended.
3. Claims 2 – 3 have been cancelled.
4. Claims 1 and 4 – 8 are currently pending and have been examined.

Response to Amendments

5. Amendments to the claims have been submitted with this response and are acknowledged.

Response to Arguments

6. Applicant's arguments received on October 22, 2008 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. However, in an effort to elucidate the applicability of the selected prior art, the Examiner has provided a riposte to the Applicant's arguments.

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7. In regards to Applicants argument to the limitation of claim 1: "determining best processes and methods according to values of said criteria by analyzing and manipulating the image using the graphic user interface"; the rejection is maintained. The graphic shown is an exemplary output specifically showing graphic for cost-benefit analysis for one scenario of inputted values. The description of FIG 13.7 on page 572 of Alter specifically addresses how manipulating the inputs such as staffing development, implementation, accrual, and the like, will alter the output, which is used in project decision making.

Furthermore, in respect to Applicants arguments pertaining to physical consolidation of IT sites in a company; in contrast to Applicants arguments, Lacey explicitly shows a physical consolidation of IT sites of a company. Referring Applicant again to a specific section of the reference: see at least Lacey page 373 "...savings by consolidating five mainframe data centers into two...".

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1 and 4 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alter (Alter, Steven; *Information Systems: A Management Perspective*, 2nd Edition, The Benjamin/Cummings Publishing Company, 1996) in view of Lacity (Lacity, Mary; Willcocks, Leslie P.; "An Empirical Investigation of Information Technology Sourcing Practices: Lessons from Experience", MIS Quarterly, Sept. 1998), further view of Willcocks et al. (Willcocks, Leslie; Choi, Chong; "Co-operative Partnership and 'Total' IT Outsourcing: From Contractual Obligation to Strategic Alliance?", European Management Journal, March 1995).

Claim 1

Alter teaches the following limitations:

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- *defining a project business need, the project business need being discrete and having a fixed duration* (see pp. 552-553 and 558-559; where information systems plans are linked to a company's business plan. The critical success factors include business needs such as improving customer relationships, improving supplier relationships, making the best use of inventory, and using capital and human resources efficiently and effectively. Furthermore, these business needs are broken down into business processes and can be reengineered. The project is discrete and deadline and completion dates are set, thus the project has a fixed duration.);
- *defining a project technical need, the project technical need involving resources needed to realize the project business need* (see pp. 552-553; where specific technical needs are determined and defined. The technical needs are resources that are needed to complete the project.);
- *determining, according to the project business need, a number of IT sites spread over a geographic area* (see pp. 551-559 and 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines. The data centers are determined in accordance to the business needs.);
- *determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area* (see pp. 551-559; where distinct roles are assigned to specific personnel who have the requisite skill set to perform the assigned tasks. The specific personnel are determined based on the technical requirements of the IS plan.);
- *grouping and distributing, according to technical constraints, said skilled people groups and computer equipment over said IT sites inside the geographic area* (see pp. 557 and 564-65; where skilled personnel are grouped into general roles. Equipment and personnel are distributed based on technical constraints. The technical constraints include decentralized systems that account for local variances versus centralized systems that perform cross-departmental functions well).
- *listing processes and methods used in the IT sites as determined* (see pp. 559 and 565-566; where corporate standards and procedures are determined);

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- *listing criteria allowing assessment of efficiency of said processes and methods in the IT sites as determined and according to the skilled people groups and computer equipment as determined, grouped, and distributed* (see pp. 570-574; where assessment of efficiency is determined using multiple standards and procedures);
- *creating with a graphic user interface an evolutionary image of the values of the criteria* (see p. 573; where a graph displaying costs, benefits and cumulative net benefit is created for a project);
- *determining best processes and methods according to values of said criteria* (see pp. 565-566 and 570-574; where best practices are determined and implemented and can be based on efficiency),
- *analyzing the image for determining the best processes and methods* (see p. 573; where the image is analyzed to determined the value of the project).
- *implementing the best processes and methods in the IT sites as determined* (see pp. 565-566 and 570-574; where best practices are determined and implemented and can be based on efficiency).
- *entering in a database the values of said criteria* (Prior Art of Record. See MPEP § 2144.03 for procedures regarding timely traversal of Official Notice.).

Alter fails to explicitly teach “physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic site peculiarities, which include cultural differences, language differences, and legal constraints”. Lacity, in an analogous art, teaches “physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic site peculiarities” (see Lacity pp. 373, 376, and 384; where IT data centers (site) were consolidated in order to reduce costs.). Lacity fails to explicitly consider “cultural differences, language differences, and legal constraints” in its consolidation. Willcocks, in an analogous art, explicitly teaches “cultural differences, language differences, and legal constraints” in consolidating and outsourcing (see Willcocks pp. 69-71; where cultural differences, language differences, and legal constraints are

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considered in outsourcing.). The advantage of such a feature that it facilitates the success of an IS outsourcing plan. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine the feature of “physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic site peculiarities, which include cultural differences, language differences, and legal constraints” taught by Lacey and Willcocks to Alter in order to facilitate the success of the IS outsourcing plan, which is a goal of Alter (see Alter p. 552).

Claims 4 and 5

The combination of Alter/Lacey/Willcocks fails to explicitly teach the following limitations, however the examiner takes **Official Notice** to:

- *repeating the steps of listing criteria, determining best processes and methods, and*
- *implementing the best processes and practices.*

It is old and well known in the art to repeat steps in a process. The advantage of repeating steps is to ensure the accuracy and consistency of results due to performing the steps of the process. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to repeat the steps of the process in order to ensure the accuracy of the results of the steps, which is a goal of Alter (see p. 570).

Claim 6

The combination of Alter/Lacey/Willcocks teaches the limitations as claimed above. Furthermore, Alter teaches the following limitation:

- *IT sites are spread over more than one geographic area (see pp. 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines.).*

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Claim 7

The combination of Alter/Lacey/Willcocks teaches the limitations as claimed above. Furthermore, Alter teaches the following limitation:

- *further comprising a step of determining, before the step of determining skilled people groups and computer equipment, a management organization for the geographic area (see p. 557; where project manage roles are assigned. Each IS department or region is accounted for).*

Claim 8

The combination of Alter/Lacey/Willcocks teaches the limitations as claimed above. Furthermore, Alter teaches the following limitation:

- *further comprising after each step, a step of updating a project management tool displaying a time for executing each step of the method of claim 1 (see p. 576; where a Gantt chart is a tool used to display a time for executing steps of a project).*

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

11. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Brett Feeney** whose telephone number is **571.270.5434**. The Examiner can normally be reached on Monday-Friday, 7:45am-5:15pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **JAMES A. REAGAN** can be reached at **571.272.6710**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to **571-273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

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401 Dulany Street
Alexandria, VA 22314.

24 November 2008

/BRETT FEENEY/

Examiner, Art Unit 4114

/Bradley B Bayat/

Supervisory Patent Examiner, Art Unit 3624

